

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of

Atty Dkt. 2558-78

C# M#

GOBLE *et al.*

JUN 27 2005

TC/A.U.

3743

Serial No. 10/808,484

Examiner: Dahbour, Fadi H.

Filed: March 25, 2004

Date: June 27, 2005

Title: AN ELECTROSURGICAL INSTRUMENT AND  
AN ELECTROSURGERY SYSTEM INCLUDING  
SUCH AN INSTRUMENT

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

**RESPONSE**

This is a response/amendment/letter in the above-identified application and includes an attachment which is hereby incorporated by reference and the signature below serves as the signature to the attachment in the absence of any other signature thereon.

**Fees are attached as calculated below:**

Total effective claims after amendment 40 minus highest number  
previously paid for 40 (at least 20) = 0 x \$50.00 \$0.00 (1202)/\$0.00 (2202) \$ 0.00

Independent claims after amendment 7 minus highest number  
previously paid for 7 (at least 3) = 0 x \$200.00 \$0.00 (1201)/\$0.00 (2201) \$ 0.00

If proper multiple dependent claims now added for first time, (ignore improper); add  
\$360.00 (1051)/\$180.00 (2051) \$

Petition is hereby made to extend the current due date so as to cover the filing date of this  
paper and attachment(s) One Month Extension \$120.00 (1251)/\$60.00 (2251)

Two Month Extensions \$450.00 (1252)/\$225.00 (2252)

Three Month Extensions \$1020.00 (1253)/\$510.00 (2253)

Four Month Extensions \$1590.00 (1254)/\$795.00 (2254) \$

Terminal disclaimer enclosed, add \$130.00 (1814)/\$65.00 (2814) \$

☐ Applicant claims "small entity" status. ☐ Statement filed herewith

Rule 56 Information Disclosure Statement Filing Fee \$180.00 (1806) \$

Assignment Recording Fee \$40.00 (8021) \$

Other: \$

**TOTAL FEE ENCLOSED \$ 0.00**

The Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, in the fee(s) filed, or asserted to be filed, or which should have been filed herewith (or with any paper hereafter filed in this application by this firm) to our Account No. 14-1140. A duplicate copy of this sheet is attached.

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NIXON & VANDERHYE P.C.  
By Atty: Robert A. Molan, Reg. No. 29,834

Signature: Robert A. Molan



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GOBLE et al..

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\* \* \* \* \*

June 27, 2005

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

**RESPONSE TO OFFICE ACTION**

Sir:

Reconsideration of this application is respectfully requested.

On April 1, 2005, the Examiner rejected claims 1-40 in this application based on double patenting of the "same invention" type under 35 U.S.C. §101, as claiming the same invention as that of claims 1-40 of prior U.S. Patent No. 6,758,846. Applicants contend that the Examiner's §101 double patenting rejection is incorrect and should be withdrawn because the claims published in the cited '846 patent are incorrect in that they fail to include amendments to such claims reflected in an Examiner's Amendment included in a Supplemental Notice of

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Allowability issued on March 15, 2004 in Application No. 90/773,893, filed February 2, 2001, the application underlying the '846 patent. The Examiner's Amendment was issued by Examiner Fadi Dahbour after approval given by the undersigned in a telephone interview on March 10, 2004. A copy of the Supplemental Notice of Allowability with the Examiner's Amendment showing changes to independent claims 1, 22, and 36-39 of the '846 patent is submitted with this Response as Attachment A to this Response.

The amendments to claims 1, 22 and 36-39 were suggested by Examiner Dahbour in response to a Supplemental Information Disclosure Statement filed in the '893 parent application submitting for consideration by Examiner Dahbour U.S. Patent No. 6,632,193 B1 to Davison *et al.*. The Davison '193 patent was listed in the Form PTO-1449, filed with this application on March 25, 2004. A copy of the Davison patent is attached as Attachment B for the Examiner's consideration.

Also included with this Response at this time as Attachment C is a copy for a Request for a Certificate for Correction filed to correct the claims of the '846 patent to conform them to the claims, as amended by the Examiner in the Examiner's Amendment included in the Supplemental Notice of Allowability mailed in the parent '893 application on March 15, 2004.

In view of the foregoing, it is believed that the Examiner's double patent rejection under §101 is incorrect, and that such rejection should be withdrawn.

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It is believed that no fee for filing this Response is due. However, the Commissioner is hereby authorized to charge any deficiency in the fee that may be due to the deposit account of Nixon & Vanderhye, Account No. 14-1140.

Respectfully submitted.

**NIXON & VANDERHYE P.C.**

By: Robert A. Molan  
Robert A. Molan  
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